

THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE TTAB

Mailed: July 15, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bristol-Myers Squibb Company

Serial No. 78222332

Ruth E. Lazar of Fross Zelnick Lehrman & Zissu, P.C. for Bristol-Myers Squibb Company.

Heather D. Thompson, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Chapman, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Bristol-Myers Squibb Company is seeking to register the mark PRINCETON PHARMACEUTICAL PRODUCTS for a "house mark for a line of pharmaceutical preparations," in International Class 5.¹ The application is based upon an allegation of a bona fide intention to use the mark in commerce.

¹ Application Serial No. 78222332, filed March 6, 2003.

The trademark examining attorney has refused registration under Section 2(e)(2) of the Trademark Act on the ground that applicant's mark is primarily geographically descriptive of its goods.

When the refusal was made final,² applicant appealed. Briefs have been filed. An oral hearing was not requested. It is the examining attorney's burden to establish the prima facie case in support of the refusal of registration. A prima facie case for refusal under Section 2(e)(2) that the mark is primarily geographically descriptive of the goods requires a showing that (1) the mark's primary significance is a generally known geographic location; and (2) that the relevant public would be likely to make a goods/place association, i.e., would be likely to think that the goods originate (or will originate) in the place named in the mark. See *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); *In re Nantucket*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988).

A mark is not "primarily" geographic where the geographic meaning is minor, obscure, remote, or unconnected with the goods. *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); and

² The examining attorney also issued and subsequently made final a requirement under Trademark Rule 2.61(b) that applicant specifically state whether or not its goods are manufactured in Princeton, New Jersey. We have deemed this requirement waived as discussed later in this decision.

Serial No. 78222332

In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 867 (Fed. Cir. 1985) (use of a geographic term in a fictitious, arbitrary or fanciful manner, is not "primarily" as a geographic designation.)

Thus, registration should not be refused where, for example, there is a genuine issue that the place named in the mark is so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied; or (2) an admittedly well-recognized term has other meanings, such that the term's geographical significance may not be the primary significance to prospective purchasers. See In re Cambridge Digital Systems, 1 USPQ2d 1659 (TTAB 1986).

Where, on the other hand, there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed from the fact that the applicant's own goods come from the geographical place named in the mark. See In re Societe General des Eaux Minerals de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); and In re Cambridge Digital Systems, *supra*.

Turning to the first part of the test, the examining attorney has submitted a listing from *The American Heritage*

Dictionary of the English Language, Fourth Edition (2000) that identifies "Princeton" as "[a] borough of central New Jersey north-northeast of Trenton. Founded by Quakers in 1696." This entry goes on to describe Princeton as "the seat of Princeton University (established in 1746...)." ³ The examining attorney also refers to a listing from the same dictionary that defines "pharmaceutical" as "a pharmaceutical product or preparation."

Applicant does not contend that "Princeton" is obscure or remote or that it is not a generally known geographic place. Rather it is applicant's contention that the primary significance of Princeton is not geographic because it has another meaning which is not geographic. Applicant notes that "Princeton is the home to Princeton University, a prestigious, world-renowned university founded centuries ago" as well as other esteemed educational institutions. (Response dated February 25, 2004, p. 2.) Applicant has submitted a page from the website of Princeton University (www.princeton.edu) containing a brief background and description of the University; and an entry for "Princeton University" from the website of <http://en.wikipedia.org> ("the free encyclopedia") stating that the University is "located in Princeton, New Jersey," that it is "one of the eight Ivy League universities," and that it is "widely regarded as one of the most

³ We take judicial notice of an entry in *Microsoft Encarta College Dictionary* (2001) that identifies "Princeton" as a "town" in New Jersey.

prestigious universities in the world." Applicant has also submitted the following entry from *The Columbia Gazetteer of North America* (2000) identifying "Princeton" as follows (abbreviations in original):

"borough (1990 pop. 12,016), Mercer co., W central N.J.; ...A leading education center, it is the seat of Princeton Univ., the Inst. for Advanced Study, Princeton Theological Seminary, Westminster Choir Co., St. Joseph's Col., and other institutions. Home to numerous natl. and internatl. corporate research centers and hq.

Further, applicant states, "there are two federal trademark registrations for PRINCETON and PRINCETON UNIVERISTY [sic], which are based on the acquired distinctiveness of the term PRINCETON under Section 2(f) of the Trademark Act." (Response dated February 25, 2004, p. 2.) Applicant has submitted copies of these registrations from the USPTO's TARR database.⁴

Based on the above evidence, applicant concludes that the association of the term "Princeton" with prestigious academics "is of equal if not greater significance than its association with a geographic locale." (Brief, p. 3.)

⁴ Registration No. 1498976 of PRINCETON UNIVERSITY for "providing educational services at the college and university level"; issued August 2, 1988 to The Trustees of Princeton University; Sections 8 and 15 affidavits accepted and acknowledged, respectively. "University" is disclaimed.

Registration No. 2219263 of PRINCETON for a variety of goods and services including pre-recorded audio and video tapes, computer programs, jewelry, publications, and variety store services; issued January 1, 1999 to The Trustees of Princeton University; Sections 8 and 15 affidavits accepted and acknowledged, respectively.

We find that the evidence sufficiently demonstrates that "Princeton" is the name of a generally known geographic location that is not obscure or remote to the public. The term is defined first as a geographic location in the dictionary reference submitted by the examining attorney as well as the *Gazetteer* reference supplied by applicant. The description of Princeton, New Jersey in these references in such terms as the "location of," "home of," or "seat of" the renown Princeton University as well as other leading research and educational facilities clearly enhances the term's geographic significance.

The evidence also shows that the geographic significance is the primary significance of the mark. We are unpersuaded by applicant's argument that the primary significance of "Princeton" is not geographic because the term has other meanings, and in particular, its association "with prestigious academics." As the examining attorney states in her brief, and the evidence shows, Princeton is "first and foremost" a geographic location.⁵ To the extent that "Princeton" does evoke an association with educational centers and institutions, that meaning is geographic as well. That is, the "educational" connotation is so closely connected to the town of Princeton that it does not overcome that

⁵ Applicant's reliance on *In re Cotter & Company*, 228 USPQ 202 (TTAB 1985) is misplaced here. The evidence in that case identified "West Point" as a military post or installation rather than a geographic place.

term's primary meaning as a geographic term. See, e.g., In re Oprelyland USA Inc., 1 USPQ2d 1409, 1413 (TTAB 1986) (finding THE NASHVILLE NETWORK primarily geographical notwithstanding that Nashville "has other imagery than the city of Nashville, e.g., education, i.e. the 'Athens of the South'; country music; Printer's Alley; a particular musical sound, i.e., 'The Nashville Sound', etc."). See also In re Cambridge Digital Systems, supra (finding CAMBRIDGE DIGITAL for computer systems primarily geographically descriptive notwithstanding that Cambridge is the name of a noted university in England and that Cambridge, Massachusetts is renowned for the educational institutions located there).

Applicant's reliance on the PRINCETON and PRINCETON UNIVERSITY registrations to support its position that the mark is not primarily geographic is curious. The registrations actually support the examining attorney's position, not the applicant's. They provide further evidence of the primary meaning of "Princeton" as a geographic term. The owner of these registrations presumably acknowledged the primary significance of Princeton as a geographic term as it sought registration based on a claim of acquired distinctiveness of its marks under Section 2(f) of the Trademark Act.

To the extent applicant is arguing that the geographic meaning of Princeton is no longer the primary meaning, or that the primary meaning has been overtaken by its acquired meaning as an "educational center" in view of the renown of the University, similar arguments have been addressed by the Board in the context of surnames. In particular, in *In re McDonald's Corporation*, 230 USPQ 304, 307 (TTAB 1986), the Board held:

...[F]or purposes of Section 2(e)(3) of the Act, the word "primarily" refers to the primary significance of the term, that is, the ordinary meaning of the word, and not to the term's strength as a trademark due to widespread advertising and promotion of the term as a mark to identify goods and/or services. [Citations omitted.]

In the present situation, the term "McDonald's" has no ordinary meaning other than as the possessive form of a relatively common surname in the United States. The Board readily concedes that the association of "MCDONALD'S" as a source indicating trademark and service mark has probably overtaken the original meaning of the word as a surname. However, this is due to the distinctiveness that has been acquired by the term over the years. ...

The primary significance of term "Princeton" is geographic, and the primary significance of PRINCETON PHARMACEUTICAL PRODUCTS as a whole is geographic. The addition of generic and/or merely descriptive words to a geographical term does not overcome the primary geographic significance of the mark as a whole. See *In re U.S. Cargo Inc.*, 49 USPQ2d 1702 (TTAB 1998); and *In re Cambridge Digital Systems*, supra. Unlike the composite marks in

the cases relied on by applicant such as *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999) (SYDNEY 2000 for advertising and business services) and *In re Jim Crockett Promotions, Inc.*, 5 USPQ2d 1455 (TTAB 1987) (THE GREAT AMERICAN BASH for wrestling matches), there is nothing added to PRINCETON, a geographic term, to render the mark in its entirety registrable. The wording PHARMACEUTICAL PRODUCTS is generic for pharmaceutical preparations, and the combination does nothing to alter the geographic significance of PRINCETON alone.

We find no genuine issue that the primary significance of PRINCETON PHARMACEUTICAL PRODUCTS is a geographic place which is not obscure or remote but rather is generally known to the public.

With respect to the second part of the test, the examining attorney argues that purchasers are likely to believe that applicant's goods will originate in Princeton because (1) at the least, applicant's goods are researched and developed in Princeton and (2) Princeton is known for pharmaceutical products and pharmaceutical companies. In support of her position, the examining attorney has submitted pages from applicant's website (www.bms.com); pages of an Internet search summary; and excerpts of articles obtained from the NEXIS database. This evidence shows, according to the examining attorney, that pharmaceutical

products in general and applicant's pharmaceutical products in particular are connected to Princeton, New Jersey.

Applicant, on the other hand, argues that the evidence is insufficient to establish the requisite goods/place association. Specifically, applicant contends that the examining attorney has not established that Princeton "is known for or associated with pharmaceutical products" (Response dated February 25, 2004, p. 4); that while applicant does maintain a research facility in Princeton, this fact is not widely known to purchasers such that there would be any association with applicant and Princeton on the part of consumers at large; that applicant is a global pharmaceutical company and maintains other major research facilities in the United States and throughout the world; and that there is no evidence that consumers "make any association at all between Princeton and pharmaceutical products." (Reply Brief, p. 3.)

In establishing a prima facie case that there is a goods/place association between pharmaceutical products and Princeton, the examining attorney need not show that the public would actually make the asserted association, i.e., that the public actually believes the goods originate in Princeton. Rather the examining attorney need only show a "reasonable basis" for concluding that the public would make the goods/place association. In re Loew's Theatres, Inc., supra at 868.

Thus, contrary to applicant's contention, the examining attorney need not show that Princeton, New Jersey is "known for pharmaceutical products" or that applicant's research facility is "widely known" to purchasers, or that "consumers at large" would actually make the association. In fact, where, as here, it has been shown that the primary significance of the mark is geographic and the place is not obscure or remote, it is sufficient to show that applicant's goods originate or will originate in the area named in the mark.⁶ In re Carolina Apparel, 48 USPQ2d 1542, 1543 (TTAB 1998) (if a geographic term in a mark is neither remote nor obscure and the geographic significance is the primary connotation of the term, and where the goods or services actually originate from the geographic place designated in the mark, a public association of the goods or services with the place may ordinarily be presumed); and In re Handler Fenton Westerns, 214 USPQ 848 (TTAB 1992). Thus, we turn to the question of whether applicant's goods originate or will originate from Princeton, New Jersey.

We note in this regard that the examining attorney required, in her initial Office action, that applicant indicate specifically whether the goods will be manufactured or produced

⁶ Unlike the obscure and remote French town of Vittel in In re Societe General des Eaux Minerals de Vittel S.A., supra, the evidence in the present case shows that the town of Princeton is generally known to the American public.

in, or will have any other connection with, Princeton, New Jersey. Applicant's response was evasive, stating only that its corporate offices are located in New York, that it does have a research facility located in Princeton, New Jersey, and that its research center is not a manufacturing facility. (Response dated February 25, 2004, p. 4.) The examining attorney, noting that applicant failed to address the requirement, made the requirement final. In response, applicant stated: "Applicant wishes to clarify that although it has a research facility in Princeton, the pharmaceuticals that are the subject of research are neither manufactured nor otherwise produced *at this facility*." (Req. for Recon., unnumb. p. 4, emphasis added.)

It seems to us that applicant has carefully avoided directly answering the examining attorney's inquiry about whether applicant's pharmaceuticals will be produced in Princeton. However, because the examining attorney did not further pursue the requirement or even mention it in either her denial of applicant's request for reconsideration or her appeal brief, we deem the requirement waived.

Nevertheless, we find that despite applicant's failure to answer the question asked, the record as a whole, including the uncontroverted evidence submitted by the examining attorney shows that the goods do or will in fact come from Princeton. The NEXIS evidence submitted by the examining attorney shows, and applicant

Serial No. 78222332

does not dispute, that applicant, Bristol-Myers Squibb Company, not only researches, but manufactures pharmaceuticals in Princeton, New Jersey. For example:

Chewable Ovcon-35 will be manufactured by Bristol-Myers Squibb Co. in Princeton, N.J. *Pittsburgh Post-Gazette* (Pennsylvania) (December 23, 2003); and also in *Albuquerque Journal* (New Mexico) (December 22, 2003).

Reyataz is manufactured by Bristol-Myers Squibb Co. of Princeton, N.J. *FDA Consumer*, September 9, 2003.

Peninsula Research Associates recently completed an open-label Phase 2 trial of Tequin gatifloxacin, manufactured by Bristol-Myers Squibb Princeton, N.J. *Applied Clinical Trials* (March 1, 2002).

The bridegroom, 26, was until last week a summer intern in the marketing strategy department of Bristol-Myers Squibb, the pharmaceuticals manufacturer, in Princeton, N. J. *The New York Times* (August 19, 2001).

Bristol-Myers Squibb Co., based in Princeton, N.J., manufactures Glucophage *Crain's Detroit Business* (June 25, 2001).

Applicant's broadly worded identification for a "line of pharmaceutical preparations" encompasses all pharmaceuticals, including those pharmaceuticals referenced above. Even if applicant's "PRINCETON" line of pharmaceuticals is not or will not be actually manufactured in Princeton, at a minimum, the NEXIS and other evidence of record shows that significant activities relating to applicant's pharmaceutical products emanate from Princeton, New Jersey. Applicant admittedly has a pharmaceutical research facility in Princeton. Moreover,

applicant has received media recognition relating to the town of Princeton. The "Newsroom" page of applicant's website contains an article dated June 24, 2003 from Time Inc.'s *health* magazine with the following headline:⁷

Princeton, New Jersey-Based Bristol-Myers Squibb Named
Among 10 Healthiest Companies For Women In U.S.:
Health Report

In addition, applicant's pharmaceutical research headquarters are in Princeton. The following statement appears on the "About Us - Our Company - Our History" page of applicant's website:

In 1990 the Bristol-Myers Squibb Pharmaceutical
Research Institute was established with headquarters
in Princeton, New Jersey...

Clearly, the record shows that a public association is likely between applicant's goods and Princeton, New Jersey in view of the fact that, at a minimum, applicant has a pharmaceutical research facility and moreover its pharmaceutical research headquarters there. See, e.g., *In re Nantucket Allserve, Inc.*, 28 USPQ2d 1144, 1146 (TTAB 1993) (NANTUCKET NECTARS is primarily geographically descriptive of soft drinks,

⁷ Applicant, in its reply brief (p. 4), argues that because this statement "was not created by Applicant but rather by a third-party" it is of no probative value. We find the statement probative, not for the truth of the matter asserted, but as evidence that applicant has a substantial presence in Princeton. We also note that the statement appears on applicant's own website and applicant has not disputed its accuracy.

where company has its research and development center, but not its manufacturing facilities, on Nantucket).

Under the circumstances, nothing more need be shown by the examining attorney in order to establish a goods/place association. See *In re Opryland USA Inc.*, supra at 1413 (TTAB 1986) ("[I]n that the evidence shows a substantial part of appellant's commercial activities emanate from or are related to Nashville, Tennessee, and that city is not obscure or remote, it is unnecessary for the Examining Attorney to establish by other evidence that a services/place relationship exists between appellant's services and the city of that name.>").

However, there is additional support in the record for a goods/place association. Not only are applicant's own pharmaceutical research center and headquarters located in Princeton, but the *Gazetteer* entry submitted by applicant states that Princeton is "[h]ome to numerous nat[ional], and internat[ional], corporate research centers and [headquarters]." The NEXIS evidence and Internet search summary made of record by the examining attorney similarly indicate that other pharmaceutical companies (e.g., Convance, Inc., Novo Nordisk Pharmaceuticals, Ranbaxy Pharmaceuticals Inc., Lexicon Pharmaceuticals) are located in or near Princeton, New Jersey.

We find that the record establishes prima facie that the public is likely to believe that applicant's pharmaceutical products emanate from Princeton, New Jersey.⁸

The fact that applicant's corporate headquarters are not in Princeton or that applicant has research facilities in geographic locations other than Princeton does not detract from the prima facie case made by the examining attorney or the perception of Princeton as at least one of the geographic sources of applicant's pharmaceuticals. See, e.g., *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988) (whether an applicant manufactures some of the goods outside of the geographical area named in the mark is not controlling).

In further support of its position that the mark is registrable, applicant states that it is the owner of an incontestable registration (Registration No. 1432671) for the same mark, PRINCETON PHARMACEUTICAL PRODUCTS, for "analgesics and anti-inflammatory pharmaceutical preparations." Applicant argues that "the nature of the goods in both the prior registration and the present application is identical, i.e., pharmaceuticals." (Brief, p. 9., emphasis in original.) Applicant also states that

⁸ Thus, this case is distinguishable from the cases relied on by applicant such as *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (SDNY 1951), *aff'd*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) and *In re Jacques Bernier, Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990). The evidence in those cases, unlike the present one, did not establish a goods/place association.

Serial No. 78222332

it was the owner of now cancelled Registration No. 1488069 (cancelled in 1994) "of the same mark for the identical goods." (Brief, p. 2.) It is applicant's contention that the issuance of these registrations "is prima facie evidence that the [USPTO] did not consider this mark to be geographically descriptive, which should govern the current registrability analysis under principles of res judicata and collateral estoppel." (Id.)

Applicant did not furnish copies of these registrations or the contents of the registration files and the Board does not take judicial notice of such records. However, because the examining attorney did not object on this basis, we will consider applicant's arguments related thereto. For purposes of this decision, we will assume that both registrations are what applicant represents them to be including that they both issued on the Principal Register.

We disagree that the refusal to register constitutes a collateral attack on applicant's existing Registration No. 1432671. While the goods in that registration are identified as "analgesic and anti-inflammatory pharmaceutical preparations," the goods in the present application are identified broadly as a "house mark for a line of pharmaceutical preparations," which would logically include additional and different pharmaceutical products. Ownership of an incontestable registration does not give applicant a right to register the same mark for different

goods. See *In re Loew's Theatres Inc.*, supra at 869 ("Nothing in the statute provides a right *ipso facto* to register a mark for additional goods when items are added to a company's line or substituted for other goods covered by a registration."); and *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration for specific services involving credit cards does not automatically entitle applicant to a registration for broader financial services). Each application for registration of a mark for particular goods must be separately evaluated. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and *In re McDonald's Corporation*, 230 USPQ 304, 307 (TTAB 1986). See also *In re Stenographic Machines, Inc.*, 199 USPQ 313, 317 (Comm'r Pats. 1978) ("Consistency of Office practice must be secondary to correctness of Office practice.").

Furthermore, collateral estoppel does not apply to cancelled registrations. A cancelled registration is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. See, e.g., *In re Hunter publishing Company*, 204 USPQ 957, 963 (TTAB 1979) (cancellation "destroys the Section [7(b)] presumptions and makes the question of registrability 'a new ball game' which must be predicated on current thought.").

In any event, applicant has failed to provide potentially relevant information about the registrations. We have no

information as to whether those registrations issued under Section 2(f) and we are left to speculate as to what the record in those cases showed, such as whether there was any inquiry by the examining attorney in those cases as to the geographic nature of the mark.

Finally, we note that applicant has included in its brief a typed listing of third-party registrations that consist of or include the term "Princeton." The listing identifies only marks, registration numbers and goods/services. Applicant argues based on this evidence that the registration of the term "for a broad spectrum of goods and services...is evidence of its registrability on the Principal Register." (Brief, p. 10.) The examining attorney objected to the listing only insofar as copies of the registrations were not submitted and not to the timeliness of the evidence. We have therefore treated the evidence as properly of record. However, we find it of no probative value for a number of reasons. Most notably, applicant has omitted significant information about the listed registrations such as whether the marks issued on the Principal Register, or whether they issued under Section 2(f), or whether the geographic terms in the marks were disclaimed, making it impossible to evaluate the evidence in any meaningful way.

We find that the examining attorney has made a prima facie case that applicant's mark is primarily geographically

Serial No. 78222332

descriptive of applicant's goods and that applicant has failed to rebut the prima facie case. See *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003).

Decision: The refusal to register is affirmed.